



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/375,415	08/17/1999	YVES SAVIDAN	040388/0115	5041

7590

03/24/2003

FOLEY & LARDNER
3000 K STREET N W
BOX 25696
SUITE 500
WASHINGTON, DC 200078696

EXAMINER

KUBELIK, ANNE R

ART UNIT	PAPER NUMBER
----------	--------------

1638

DATE MAILED: 03/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/375,415

Applicant(s)

SAVIDAN ET AL.

Examiner

Anne R. Kubelik

Art Unit

1638

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 March 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 25-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 25-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 June 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The new claims numbered 20-25 in the submission filed on 6 March, 2002, in Paper No. 14 have been renumbered claims 25-30 in accordance with 37 CFR 1.126. Applicant cancelled the original claims 20-24 in Paper No. 5 filed concurrently with the application. Applicant is reminded that claim numbers from cancelled claims are not reused.

2. Claims 1-14, 16 and 19 were cancelled, as also requested in Paper No. 14. Claims 25-30 are pending.

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. The drawings are objected to for the reasons indicated on the accompanying form PTO 948. Corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance. See 37 CFR 1.85(a) and MPEP 608.02(b).

5. The title of the invention is not descriptive of the instant invention. A new title is required that is clearly indicative of the invention to which the claims are directed. Note that titles can be up to 500 characters long.

6. This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.

Response to Amendment

7. The rejection of claim 11 under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter, as it would apply to claims 25-30, is WITHDRAWN because claim 11 is cancelled and because claims 25-27 are directed to isolated nucleic acids.

8. The rejection of claim 11 under 35 U.S.C. 102(b) as being anticipated by Rhodes et al, as it would apply to claims 25-30, is WITHDRAWN because claim 11 is cancelled and because claims 25-27 are directed to isolated nucleic acids.

Claim Rejections - 35 USC § 112

9. Claims 25-30 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter that was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The rejection is repeated for the reasons of record as set forth in the Office action mailed 24 August, 2001, as applied to claims 11 and 19.

Applicant's arguments filed 6 March, 2002, have been fully considered but they are not persuasive. Applicant urges that guidance to the sequence of the elongate gene is provided in the form of the partial sequences present in the specification. Applicant also urges that methods of isolating the elongate gene and of maize transformation are taught in the specification (response pg 2-3).

This is not found persuasive because the partial sequences (*e.g.*, from Example 4) do not provide the entire sequence of the gene; the longest is only 75 nucleotides long. Applicant presents no evidence that these come from the *Elongate* gene or that transformation of a plant

Art Unit: 1638

with one of these sequences would make the plant apomictic. Additionally, two of the sequences are described as having homology to *Arabidopsis* histone H1-1 and yeast cdc36.

As discussed in the prior Office action, apomixis is not the result of a single mutation in a single gene (Ozias-Akins et al, 1998, Proc. Natl. Acad. Sci. USA 95:5127-5132; pg 5130, right column, paragraphs 2-3). Additionally, the art does not teach that the *elongate* mutant is apomictic, as discussed in the prior Office action.

10. Claims 25-30 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The rejection is repeated for the reasons of record as set forth in the Office action mailed 24 August, 2001, as applied to claims 11 and 19.

Applicant's arguments filed 6 March, 2002, have been fully considered but they are not persuasive. Applicant urges that they intend to deposit a plasmid containing the mutated *elongate* gene of maize, which they possessed as of the filing date of the instant application. Applicant also urges that they have described the function of the encoded *elongate* protein as causing apomixis (response pg 3).

This is not found persuasive because such a plasmid is not mentioned in the specification, and it would thus constitute new matter. A description of the function of a protein encoded by a DNA is not enough - the structural features, *i.e.*, the sequence, of the gene is required.

See *University of California v. Eli Lilly*, 119 F.3d 1559, 43 USPQ 2d 1398 (Fed. Cir. 1997):

The name cDNA is not in itself a written description of that DNA; it conveys no distinguishing information concerning its identity. While the example provides a process for obtaining human insulin-encoding cDNA, there is no further information in the patent pertaining to that cDNA's relevant structural or physical characteristics; in other words, it thus does not describe human insulin cDNA Accordingly, the specification does not provide a written description of the invention

Art Unit: 1638

See *Amgen Inc. v. Chugai Pharmaceutical Co. Ltd.*, 18 USPQ 2d 1016 at page 1021:

A gene is a chemical compound, albeit a complex one, and ... conception of a chemical compound requires that the inventor be able to define it so as to distinguish it from other materials Conception does not occur unless one has a mental picture of the structure of the chemical or is able to define it by its method of preparation, its physical or chemical properties, or whatever characteristics sufficiently distinguish it. It is not sufficient to define it solely by its principal biological property, *e.g.*, encoding human erythropoietin, because an alleged conception having no more specificity than that is simply a wish to know the identity of any material with that biological property.

11. Claims 25-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that Applicant regards as the invention. Dependent claims are included in all rejections.

Claim 25 is indefinite in its recitation of "homologous sequence". The manner in which the sequence differs from that of the mutated elongate gene is unclear. It is also unclear if wild-type elongate genes would be considered homologous sequences.

Claim 26 lacks antecedent basis for the limitation "The nucleic acid".

Claim 28 lacks antecedent basis for the limitation "the nucleic acid".

Claims 28-30 are indefinite because they lack agreement between the preamble of the methods and the positive method steps. Methods must be circular; the final step must generate the item the method is intended to produce. For example, the method of producing apomictic plants in claim 28 ends in introducing a nucleic acid into a plant, when it should end in the production of apomictic plants.

12. Claims 25-30 are free of the prior art, given the failure of the prior art to teach an isolated nucleic acid encoding a mutated elongate gene from maize, and given the unpredictability of the association of an apomictic phenotype with the elongate mutation, as discussed above.

Art Unit: 1638

Conclusion

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anne R. Kubelik, whose telephone number is (703) 308-5059. The examiner can normally be reached Monday through Friday, 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amy Nelson, can be reached at (703) 306-3218. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the patent analyst, Kimberly Davis, at (703) 305-3015.

Anne R. Kubelik, Ph.D.

August 15, 2002

DAVID T. FOX
PRIMARY EXAMINER
GROUP 180/1638

